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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,689	09/09/2003	Peter Gerrard	0112300-1535	7521

7590 02/12/2007
Bell, Boyd & Lloyd LLC
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EXAMINER

YOO, JASSON H

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/659,689	Applicant(s) GERRARD ET AL.	
	Examiner Jasson H. Yoo	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 15-29, 31-41, 43-50, 52-62, 64-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff'334 (US No. 6,312,334) in view of *Let's Make a Deal* – Wikipedia (http://en.wikipedia.org/wiki/Let's_Make_a_Deal) ("LMAD") and in view of Pau et al. (US 2002/0042294).

Yoseloff teaches implementing "Let's Make a Deal" on the slot machine, but doesn't explicitly teach how this would be done (col. 7:19-28). Figs. 6 and 7 are said to illustrate an embodiment for playing "Let's Make a Deal". The references *Let's Make a*

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Deal – Wikipedia teach the details of “Let’s Make a Deal”. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yoseloff in view of LMAD to have an offer/acceptance game in order to implement Yoseloff suggestion to implement “Let’s Make a Deal”.

LMAD is a television game showed first aired in 1963. During the show, the contestant is offered multiple award offers (pages 1-3). The multiple award offers (such as a plastic egg or a box which may reveal \$1000, a new kitchen appliance, or something worthless; described in page 2). Throughout the show, the contestant is given several chances to trade in the award item in exchange for another item. As the game progresses, the prize value offered to the contestant increases. Then the contestant is offered a chance to play the Big Deal of the Day (page 3-4). The contestant is allowed to keep their winnings or give up everything already won for a spot in the Big Deal of the Day. The Big Deal of the Day is offered to the top winners (page 3). A contestant is a top winner by receiving the greater of the award offers, or when obtaining the greatest value item when trading in and exchanging award items. Therefore, the Big Deal of the Day allows the player to keep the greater of previous offers (greater of the first and second potential award offer), or receive a final offer (or third offer).

Yoseloff discloses a first segment of the game, offering a winning outcome and an associated payout (col. 3:51-54). Furthermore, the first segment of the game may

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be predetermined outcomes such as number of winning outcomes or achieving one of the specific or general groups of winning outcomes (col. 3:27-33). Implementing "Let's Make a Deal," the first segment can have an predetermined outcome or a winning outcome providing an award offer to the player as the initial offer (col. 7:21-24). Then the player is provided an option (entering the second segment of the game as described in col. 3:55-60) to accept or reject the prize offered in the first segment, to receive instead a third award offer (col. 7:25-63).

Yoseloff in view of LMAD significantly teaches the claimed invention as discussed above, but fails to teach each award offer has the equivalent ratio of a winning outcome to winning amount, wherein each award offer has a different range of award values, with different probability of obtaining the award. As practiced in every wagering game industry, Pau discloses a plurality of award offers wherein each award offer has equivalent ratio of a winning outcome to winning outcomes, wherein each award offer has a different range of award values, with different probability of obtaining the award. Pau's gaming device provides players a fair way to obtain large prizes by decreasing the probability of winning the large prizes (Figs. 3, 5, 7, 8). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff in view of LMAD gaming device and have awards selected from a range of number have a greater upper end than another range of number, and having the ranges weighted differently in order to offer the possibility to win from a wide range of awards, and control the odds of the awards. Furthermore, Yoseloff in view of LMAD and Pau, does not specifically disclose a first potential award offer formed from a first

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quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity, and the second values are, on average greater than the first values; and the quantity of values used for form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to from the second award offer. Nevertheless the award offers formed from various quantity of values with various average values is a design variation of Pau's game scheme in which each award offer has the equivalent ratio of a winning outcome to winning amount, wherein each award offer has a different range of award values, with different probability of obtaining the award. It is well known in the art to weigh values within ranges in order to have certain values chosen more than others and have awards to have approximately the same expected value. This is an important aspect of casino management used to control the odds in which awards or other features are present. Yoseloff in view of LMAD demonstrate this by providing various games with different winning combinations, which further provides different winning awards; each with approximately the same expected value (Yoseloff, col. 1:46-65). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff in view of LMAD and Pau, gaming device and have a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity, and the second values are, on

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average greater than the first values; and the quantity of values used for form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to from the second award offer in order to offer the possibility to win from a wide range of awards, and control the odds of the awards.

Claims 1, 11, 19-20, 22, 29, 31, 35-37, 39, 46, 48, 50, 52, 55-57, 68-70, 74;

Yoseloff in view of LMAD and in view of Pau discloses a gaming device operable under control of a processor and a method of operating a gaming device comprising:

At least two potential award offers [The two potential award offers can be a large payout or a small in payout i.e. awards hidden behind one of the doors in fig. 7 (col. 3:5-8)] adapted to be formed and displayed to a player (Yoseloff, Visual Display 36 in Fig. 3), wherein

a display device wherein the processor is operable with the display device and programmed to:

determine the greater of the first and second potential award offers; cause the display device to display an initial offer to the player, wherein the initial award offer is the determined greater of the first and second potential award offers (when player is a top winner, the player is offered the greater award offer, page 3 in LMAD); and enable the player to accept the initial award offer or reject the initial award offer to instead receive a third offer (After a predetermined condition, such as being the top winner, the player can instead receive a third offer in the second game segment. The player must

be offered an initial offer, in order to use the initial offer to wager as part of the second game segment. Yoseloff, cols. 3-19-33, 7:19-63).

The limitations of claims 1, 36, 57, 69, and 70, regarding the quantity of values, the average values, and whether or not to include one or more values from each of the groups when forming each award offer will be discussed below.

The limitation of claim 46, regarding the values for each award offer is selected to add to the predetermined totals will be discussed below.

Claims 2-5, 12, 21, 25-28, 38, 40, 47, 58-60, 75-76 (and the limitations of independent claims 1, 36, 57, 69, and 70 regarding the quantity of values and the average values when forming each award offer); Yoseloff'334 further teaches the award offers can be offered by any wagering game (cols. 1:46-65, 2:29-52, 3:15-18) which are selected from different range of values (a game of wheel of fortune with different ranges of values, col. 7:57-63; or any other modified games discussed above such as blackjack, dominoes, mah-jong can be played with different range of values), and the average values ranging in a particular set are weighted differently (Depending on the game played, the weight of values are different; i.e. an Ace of spades is weighted more or have a greater upper end than a two of diamonds). The award offers formed from various quantity of values with various average values is a design variation of Pau's game scheme in which each award offer has the equivalent ratio of a winning outcome to winning amount, wherein each award offer has a different range of award values, with different probability of obtaining the award. It is well known in the art to weigh values

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within ranges in order to have certain values chosen more than others and have awards to have approximately the same expected value. This is an important aspect of casino management used to control the odds in which awards or other features are present. Yoseloff in view of LMAD demonstrates this by providing various games with different winning combinations, which further provides different winning awards; each with approximately the same expected value (Yoseloff, col. 1:46-65).

Claim 24 (and the limitations of independent claim 46 regarding the values for each of the award offer is selected to add to the predetermined totals). LMAD discloses the prizes are predetermined (behind doors, boxes, or curtains, page 1). Yoseloff also discloses a guessing game (selecting a door), where the awards are predetermined before they are displayed (selecting a winning door, col. 7:19-63).

Claims 6, 16, 23, 32, 44, 49, 53, 61, 65, 77; Yoseloff discloses the values are selected randomly from different groups of varying values (as discussed above, the varying values can be different values of the cards in a hand, or any ranking of symbols within a wagering game). Yoseloff also teaches the game could involve a wheel of fortune wheel (col. 7:57-63) with varying values within the wheels. Although Yoseloff does not specifically teach the values within a group are taken or selected in an order from lowest to highest, or formed by selecting sequentially from the groups, it is well known in the art to select prizes in specific order. Many casino games, or even live game shows offer awards from lowest to greatest in value or sequentially from the

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groups in order to provide suspense and excitement for the player. Furthermore, the selection order has no effect to the prize value, when the prize value is based upon the total of the individual award unit (i.e. In a modified game of poker, where a poker hand of a royal flush giving the award value or prize value of the jackpot, gives the player the jackpot prize regardless if the Ace, came out first or the Ten came out first, or any order of the Ace, King, Queen, Jack, Ten.). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff and LMAD gaming device, and incorporate selection of order in selecting the award values from lowest to highest in order to provide suspense and excitement for the player.

The limitation of claims 16, 32, 44, 53, 65, regarding whether or not to include one or more values from the groups to form the award offer will be discussed below.

Claims 7, 17, 33, 45, 54, 66, 72-73 (and the limitation of the independent claims 16, 32, 44, 53, 65, 70 regarding whether or not to include one or more values from the groups to form the award offer); Yoseloff discloses the groups are weighted to be selected randomly more often than at least one of the other groups. Yoseloff discloses the games could be a combination or a modified version of any wagering game such as poker, mah jong, dominoes, twenty one, black jack, or games that does not even include playing cards (cols. 1-5). Yoseloff also discloses the game could be played involving a wheel of fortune wheel wherein the prizes weighted so the greater value prizes are selected less than the less valued prizes. As discussed above, it is well known in the art to offer awards in groups weighted to be selected randomly more often

than at least one of the other groups, and to include one or more values from the groups, in order to provide a plurality of award outcomes. This is an important aspect of casino management used to control the odds in which awards or other features are present. Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff and LMAD gaming device, and incorporate weighted groups, in order to provide a plurality of award outcomes, and maintaining the odds favorable to the casino.

Claims 8-9; Yoseloff discloses a gaming device of claim 6, as discussed above. However Yoseloff does not specifically teach the groups are arranged in a grid, and wherein values of a same relative amount within their respective groups are arranged adjacently in the grid, nor does it teach some of the values of the same relative amount between the groups are the same values. However this is an aesthetic design choice in displaying the award points in a particular arrangement. Aesthetic design changes that do not impact the function of system cannot be relied on to distinguish the claimed subject matter over prior art. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, the claimed subject matter of groups and values arranged in a grid is an aesthetic design choice and does not functionally alter the probability of the selection of the award values or the selection of the first, second or third award offers as suggested by Yoseloff. Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff gaming device and arrange the groups and

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values in a grid in order to provide a display of awards in an organized way, allowing the players to easily see the range of award values that are available.

Claims 10, 18, 34, 55, 67; Yoseloff discloses the values are added to form the first, second and third awards offers and the potential award offers is a combination of at least two values. Yoseloff discloses the game apparatus is used with any wagering game such as blackjack, which is played by the sum of the values. Yoseloff also discloses the award can be cumulative award basis or partial accumulated award basis (leading to the selection of the second and third award offers) which can be the added form of the values in any wagering game (col. 5:28). Yoseloff also discloses the award can be based on a wheel of fortune wheel (adding the award points from the wheel), and can be a combination of symbols (col. 7:57-63).

Claims 13, 29, 41, 50, 62, 78; Yoseloff discloses the gaming device is controlled through a computer storage device (ROM memory 46, col. 10:44) and the gaming device includes an on-board processor that forms the award offers (MPU 33, col. 10:42-46).

Claims 22, 48; Yoseloff and LMAD does not specifically teach that the first award offers are displayed before the values of the second award offers, which are both displayed before the values of the third award offer. However, the order of which the award offers are displayed is an aesthetic design choice. Aesthetic design changes that

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do not impact the function of system cannot be relied on to distinguish the claimed subject matter over prior art. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, the claimed subject matter of the order in which the award offers are displayed is an aesthetic design choice and does not functionally alter the gaming system suggested by Yoseloff and LMAD in which the player is given a choice of three award offers, where the values for each award offer is randomly selected.

Claim 71, Yoseloff discloses the second offer occurs after the termination of the first offer. The first offer can be a first hand of cards, and the second offer could be the second hand of cards (col. 5:21-33). The offering of the awards can be repeated a number of times before the final (third) offer (col. 5:1-20).

Claims 13-15, 29-31, 41-43, 50-52, 62-64, 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff'334 in view of *Let's Make a Deal* – Wikipedia (http://en.wikipedia.org/wiki/Let's_Make_a_Deal) and in view of Pau et al. (US 2002/0042294) as applied to claims above, and in further view of Kelly et al.'918 (US 5,816,918).

Yoseloff and LMAD discloses a gaming device as discussed above. However Yoseloff does not teach the processor is located remote from the gaming device, or the gaming device is controlled through a data network, or the data network includes an internet. In an analogous art to wagering games and methods of providing the games to the players, Kelly et al. 918 teaches of a gaming device connected to a network, and

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the Internet (col. 2:33-49). When the gaming device is connected to a network, it connects to a server which further comprises a processor (Fig. 4) Therefore it would have been obvious to one skilled in the art at the time the invention was made and modify Yoseloff and LMAD gaming device and control the gaming device through a data network and the Internet, in order to allow players to play from a remote server (col. 2:45-49), thus providing more flexibility when updating and monitoring the game.

Response to Arguments

Applicant's arguments filed 11/27/06 have been fully considered but they are not persuasive.

Applicant argues that Yoseloff in view of LMAD and Pau, does not specifically disclose a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity, and the second values are, on average greater than the first values; and the quantity of values used for form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to from the second award offer.

However, the award offers formed from various quantities of values with various average values is a design variation of Pau's game scheme in which each award offer has the equivalent ratio of a winning outcome to winning amount, wherein each award offer has a different range of award values, with different probability of obtaining the

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award. It is well known in the art to weigh values within ranges in order to have certain values chosen more than others and have awards to have approximately the same expected value. This is an important aspect of casino management used to control the odds in which awards or other features are present. Yoseloff in view of LMAD demonstrate this by providing various games with different winning combinations, which further provides different winning awards; each with approximately the same expected value (Yoseloff, col. 1:46-65). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff in view of LMAD and Pau, gaming device and have a first potential award offer formed from a first quantity of first values, the first quantity is greater than one, a second potential award offer formed from a second quantity of second values, wherein the first quantity is, on average, greater than the second quantity, and the second values are, on average greater than the first values; and the quantity of values used for form the first award offer is selected from a first range of quantities having a greater upper end than a second range of quantities employed to select the quantity of values used to from the second award offer in order to offer the possibility to win from a wide range of awards, and control the odds of the awards.

Applicant further argues that Yoseloff in view of LMAD and Pau, does not teach determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer. However, LMAD discloses a plurality of award offers. In order to receive the "third award offer" or the deal of the day, the player has already obtained the greater award as

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an initial offer. The initial award offer is used as a wager to receive the "third award offer". Therefore Yoseloff in view of LMAD and Pau, teaches determining the greatest/highest of the potential award offers as an initial offer, in order to wager for the third award offer.

Conclusion

This is an RCE of applicant's earlier Application No. 10/659,689. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 8:30-5:00.

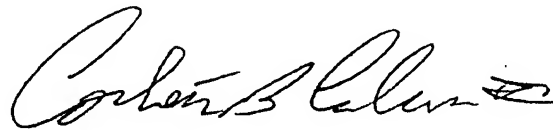
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olszewski Robert can be reached on (571)272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHY

A handwritten signature in black ink, appearing to read "Corbett B. Coburn" with a stylized flourish at the end.

**CORBETT B. COBURN
PRIMARY EXAMINER**